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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,646	12/13/2000	Wolfgang Beilfuss	S 5225 - OP/MM	4803

466 7590 11/29/2002

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EXAMINER

CHOI, FRANK I

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 11/29/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,646

Applicant(s)

BEILFUSS ET AL.

Examiner

Frank I Choi

Art Unit

1616

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspond nce address --**

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Examiner has duly considered Applicant's arguments but deems them moot in light of the new grounds of rejection herein. Examiner withdraws the finality of the prior Office Action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lutz et al.

(U.S. Pat. 6,114,366) in view of Reeve (U.S. Pat. 5,210,094), DE 2337755 (Abstract), DE 19534532 (Abstract), Raad et al. (U.S. Pat. 6,267,979), Grier et al. (U.S. Pat. 4,119,779) and Rothenburger et al. (U.S. Pat. 6,121,302) for the reasons of record set forth in the prior Office Actions in further view of Paulus et al. (US Pat. 4,166,122) or GB 1505069 and the further reasons below.

Lutz et al. (U.S. Pat. 6,114,366), Reeve (U.S. Pat. 5,210,094), DE 2337755 (Abstract), DE 19534532 (Abstract), Raad et al. (U.S. Pat. 6,267,979), Grier et al. (U.S. Pat. 4,119,779) and Rothenburger et al. (U.S. Pat. 6,121,302) were discussed in the prior Office Actions and the same are incorporated herein.

Paulus et al. teach that 5,5'-dimethyl-di-(1,3-oxazolidin 3-yl) methane which is prepared by the reaction of formaldehyde and isopropanolamine is effective as an industrial microbial agent and which can be combined with other active compounds such as, reaction products of alcohol or amines with formaldehyde, pyridine thiol-1-oxide, 1,2-benzisothiazlone and 2-mercapto-benzthiazole (Columns 1,2).

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GB 1505069 teaches that hexahydro-1,3,5-tris (2-hydroxyethyl)-(s)-triazine can be combined with 1,2-benzisothiazolone or a mixture of 2-methyl,4-isothiazoline-3-one and 5-chloro-2-methyl 4-isothiazoline-3-one and used as bactericide (Pg. 2, first column).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the combination of the specified N-formals, specified isothiazolones and specified stabilizers. However, the prior art amply suggests the same as the specified N-formals are known in the art to be used as biocides in combination with the specified stabilizers or specified isothiazolones. One of ordinary skill in the art would be motivated to combine all three with the expectation that the combination would be more effective than either one alone in that the prior art teaches that the combination of N-formaldehyde donors and 3-isothiazolones are effective biocides, that stabilizers, such as mercaptopyridine N-oxides, protect isothiazolones from degradation and are themselves microbiocides and N-formals act synergistically with mercapto pyridine as germicides (Lutz et al., Column 3, lines 22-68, Column 4, lines 1-28, Reeve, Column 3, Column 4, lines 1-30); DE 2337755, Abstract).

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion

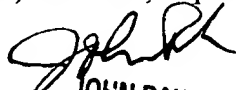
A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (703) 308-1235 and (703) 308-0198, respectively.

FIC

November 21, 2002


JOHN PAK
PRIMARY EXAMINER
GROUP 1600

